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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,793	05/04/2001	Shyh-Mei F. Ho	SVL920010041US1	1989
45728 7590 08/24/2007 SAWYER LAW GROUP LLP P.O. BOX 51418 PALO ALTO, CA 94303			EXAMINER PRICE, NATHAN E	
			ART UNIT 2194	PAPER NUMBER
			MAIL DATE 08/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/849,793

Applicant(s)

HO ET AL.

Examiner

Nathan Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

WILLIAM THOMSON  
SUPERVISORY PATENT EXAMINER

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Requirement For Information.

## **INFORMATION REQUIREMENT**

### ***Requirement For Information - 37 C.F.R. § 1.105***

**I. Applicant and Assignee of this application are required under 37 C.F.R. 1.105 to provide the following that the Examiner has determined is reasonably necessary to the examination of this application.**

This request is made in view of the prosecution history and references found by Examiner during a prior art search and will assist in determining whether certain references and commercial products constitute prior art against specific claims.

To make the record clear the examiner is requiring specific information that may be used to delineate the invention and the commercially available products in the Customer Information Control System (CICS) packages/systems.

As these are needed to provide a complete examination of the pending application it is proper to require disclosure of the following. See M.P.E.P. 704.11 and 37 C.F.R. 1.105(a)(i)-(vii).

#### **In response to this requirement, please provide:**

1. The publication date or date of sale of supportive documentary evidence, such as manuals, articles and/or program code by applicant, or assignee, that may qualify as printed publication prior art or on sale bar (35 U.S.C. 102(a) or (b)) specific to the CICS packages/systems, inclusive of support programs and add-ons, that were available prior to 8 August 2000.

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2. The trade name of any goods or services the *claimed* subject matter is embodied in, regardless of the date.

3. The citation for, the dates *initially* published and copies of any advertising and promotional literature prepared for any goods or services the *claimed* subject matter has been embodied in.

4. The citation for and copies of any journal articles describing any goods or services the *claimed* subject matter has been embodied in, regardless of dates.

5. The claimed invention appears to be an improvement over at least some of Applicant or Assignee's commercial products, identification of what is being improved must be provided in the response so as to delineate the *claimed* invention from these products, including CICS packages/systems not to exclude the versions available prior to and during the drafting of the provisional patent application 60/223,671.

6. Copies or originals of manuals covering versions CICS packages/systems *from prior to* 8 August 2000.

7. Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the *claimed* subject matter has been embodied in.

8. An explanation and analysis of how the subject matter *claimed* is patentably distinct from that which is taught in the CICS packages/systems, inclusive of the versions until the filing of the provisional application 60/223,671 on 8 August 2000. Further, this explanation must go to how these products'

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subject matter supports the instant specification as filed and how the instant invention teaches different and patentably distinguishable subject matter that Applicant regards as their invention and *claimed*.

9. Identification of any use of the claimed invention known to any of the inventors at the time the present non-provisional application was filed, and the provisional patent application 60/223,671, notwithstanding the date of the use.

10. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) used in drafting the instant application or provisional patent application 60/223,671, whether cited or not in the IDS submission(s) dated 12 February 2002.

11. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was used in the inventive process to accomplish the applicant's inventive results.

This request is made in view of the prosecution history and prior art provided and will assist in determining whether uncovered references and commercially available products might constitute prior art against specific claims pending in the application.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that

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the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

Excluding the oldest copy of the CICS packages/systems manuals required above; in responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

This requirement is subject to the provisions of 37 C.F.R. 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 C.F.R. 1.136(a).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is


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(571) 272-4196. The examiner can normally be reached on 6:30am - 3:00pm,  
Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, William Thomson can be reached on (571) 272-3718.  
The fax phone number for the organization where this application or proceeding  
is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from  
the Patent Application Information Retrieval (PAIR) system. Status information  
for published applications may be obtained from either Private PAIR or Public  
PAIR. Status information for unpublished applications is available through  
Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-  
free). If you would like assistance from a USPTO Customer Service  
Representative or access to the automated information system, call 800-786-  
9199 (IN USA OR CANADA) or 571-272-1000.

NP

  
WILLIAM THOMSON  
SUPERVISOR/CLIENT EXAMINER

### **DETAILED ACTION**

1. This Office Action is in response to communications received 11 June 2007. Claims 1, 5 and 8 are pending. Previous objections and rejections not included in this Office Action have been withdrawn.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 June 2007 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1, 5 and 8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

4. Claims 1, 5 and 8 are objected to because of the following informalities: it is not clear what is meant by "a type descriptor metamodel that language neutral" (for example, page 3 line 2). Appropriate correction is required.



### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of each of U.S. Patent No. 6,775,680; 6,904,598; 6,910,216; 6,912,719; 6,915,523; 6,948,174 and 6,964,053 in view of Ben-Shachar (US 5,761,656) and Deborin (see PTO-892 mailed with this Office Action).
6. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/849,107 in view of Ben-Shachar (US 5,761,656) and Deborin (see PTO-892 mailed with this Office Action).

This is a provisional obviousness-type double patenting rejection.

7. The claims of the cited patents and copending application are not identical. However, it would have been obvious to one of ordinary skill in the art to modify the claims with Ben-Shachar and Deborin because they are all directed towards subject matter that includes mapping communications and providing system integration. Since Ben-Shachar and Deborin together teach the subject matter of claim 1 of the present application (see rejections under 35 U.S.C. 103(a) below), modifying the claims of the cited patents and copending application with Ben-Shachar and Deborin renders claim 1 unpatentable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ben-Shachar (US 5,761,656) in view of Deborin (see PTO-892 mailed with this Office Action).

9. As to claim 1, Ben-Shachar discloses a method of processing an application request on an end user application and an application server (abstract; col. 5 lines 2 - 16) comprising:

- a) initiating the application request on the end user application in a first language with a first application program wherein the end user application is a web browser (col. 5 lines 6 - 33);
- b) transmitting the application request to the server and converting the application request from the first language of the first end user application to a form for the language running on the application server (col. 5 lines 3 - 12), wherein the end user application is connected to the application server through a connector (col. 5 lines 2 - 16, execution manager 150);
- c) processing said application request on the application server (col. 5 lines 6 - 15);
- d) transmitting a response to the application request from the application server to the end user application, and converting the response to the application request from the language running on the application server to the first language of the first end user application (col. 5 lines 12- 17); and
- e) wherein the connector comprises invocation metamodel data, application domain interface metamodel data, transaction message metamodel data, and type descriptor metamodel data (col. 4 lines 30 - 36; col. 5 lines 2 - 12, 39 - 50), wherein the connector is configured to (i) convert the application request from the first language of the first end user application as a source language to the language running on the

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application server as a target language (col. 5 lines 6 - 12), and (ii) convert a response to the application request from the language running on the application server as a source language to the first language of the first end user application as a target language (col. 5 lines 13 - 16), each comprise:

- 1) invoking connector metamodels of respective source language and target language ("mapping file" col. 5 lines 6 - 15);
- 2) populating the connector metamodels with metamodel data of each of the respective source language and target language, the metamodel data of the target language including a map, a mapset, and a mapfield (Figures 3 and 10; col. 5 lines 29 - 48; col. 9 lines 10 - 22); and
- 3) converting the source language to the target language (col. 9 lines 10- 22).

10. Ben-Shachar fails to specifically disclose a mapping support language, a web server and connector and metamodel details. However, Deborin discloses a mapping support language (p. 139 ¶ 1). Deborin also discloses a web server as claimed (Figs. 17 and 18; §1.4). Deborin also discloses wherein the connector comprises invocation and transformation capabilities, wherein the connector comprises a language metamodel to define data structures that represent connector interfaces, wherein the language metamodel indicates a source language, a target language, and a mapping between the source language and the target language, wherein the language metamodel comprises declaration text that is not editable, wherein the connector

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comprises a type descriptor metamodel that language neutral and that defines a physical realization, a storage mapping, and a plurality of constraints, wherein the type descriptor metamodel provides a physical representation of individual fields of a given data structure, wherein the type descriptor metamodel provides data types mapping between languages (Figs. 17 – 21; §1.3; 1.4; 1.5; 5.1.1; 5.4.5.2; 6.1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine these references because both references focus on providing server processing to clients by mapping requests between formats of the client and server.

11. As to claims 5 and 8, see the rejection of claim 1.

### ***Conclusion***

12. The prior art made of record on the P.T.O. 892 that has not been relied upon is considered pertinent to applicant's disclosure. Careful consideration of the cited art is required prior to responding to this Office Action, see 37 C.F.R. 1.111(c).

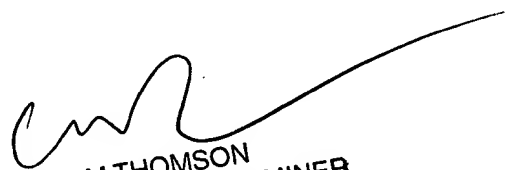
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is (571) 272-4196. The examiner can normally be reached on 6:30am - 3:00pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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NP



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SUPERVISOR  
PATENT EXAMINER